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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				KUGEL, TIMOTHY J
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/518,926

Filing Date: December 23, 2004

Appellant(s): ISHIKAWA ET AL.

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Gerald M. Murphy, Jr.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 31 March 2009 appealing from the Office action mailed 16 September 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct; although it should be noted that appellant does not explicitly state such but refers to claim 1, the sole independent claim.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,193,986	Sakurada	02-2001
US 4,379,755	Yamada	08-1983
WO 01/58279	Takahashi	08-2001
US 2003/0035859	Takahashi	02-2003

**(9) Grounds of Rejection**

The following ground of rejection is applicable to the appealed claims:

Claims 1-4 stand rejected under 35 USC § 103(a) as being unpatentable over US Patent 6,193,986 (Sakurada hereinafter) in view of US Patent 4,379,755 (Yamada hereinafter) and in further view of International Patent Application Publication WO 01/58279 (Takahashi hereinafter). US Patent Application Publication 2003/0035859 is the US equivalent to Takahashi and all references herein are taken therefrom.

Sakurada teaches a foodstuff (Column 1 Lines 5-13) comprising an water-in-oil emulsion (Column 1 Lines 14-33) wherein the oily phase comprises 0.5 to 50% of an emulsifier (Column 6 Lines 16-18) including hexaglycerol trioleate—a polyglycerol fatty

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acid ester—and sucrose fatty acid esters as exemplified in the instant specification alone of in combination (Column 4 Line 53 – Column 5 Line 31) and an oily component, including arachidonic acid, eicosapentaenoic acid and docosahexaenoic acid (Column 5 Line 47 – Column 5 Line 15)—both polyvalent unsaturated fatty acids.

Sakurada does not disclose expressly such a composition in an oil-in-water composition.

Yamada discloses an emulsion for use in cosmetics or food wherein the emulsion is of the oil-in-water type comprising a sucrose fatty-acid ester emulsifier (Column 1 Lines 16-60).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce the Sakurada foodstuff as an oil-in-water emulsion as taught by Yamada. The rationale to do so would have been the motivation provided by the teaching of Yamada that such emulsions are much desired over water-in-oil types as they have superior feel and homogeneity (Yamada Column 1 Lines 37-43 and 67-60).

Neither Sakurada nor Yamada disclose expressly the use of sucrose acetate butyrate as an emulsifying agent.

Takahashi discloses that sucrose acetate isobutyrate is an equivalent emulsifying agent to the sucrose fatty acid esters taught by Sakurada and Yamada (Takahashi 0029).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the sucrose acetate isobutyrate emulsifying agent of Takahashi in the composition of Sakurada. The rationale to do so would have been the motivation

provided by the teaching of Takahashi that sucrose acetate isobutyrate is a functional equivalent to sucrose fatty acid esters and further, since it has been held that it is *prima facie* obviousness to use a known material based on its suitability for its intended use.

See MPEP 2144.06(II) and 2144.07; *In re Fout*, 675 F2d 297, 213 USPQ 532 (CCPA 1982); *Sinclair & Carroll Co v Interchemical Corp*, 325 US 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F2d 197, 125 USPQ 416 (CCPA 1960) and *Ryco, Inc v Ag-Bag Corp*, 857 F2d 1418, 8 USPQ2d 1323 (Fed Cir 1988).

#### **(10) Response to Argument**

Appellant argues that Yamada teaches away from the use of sucrose fatty esters in the oil-in-water emulsions as instantly claimed; however, Yamada teaches that it is **not** impossible to prepare oil-in-water emulsions with hydrophilic sucrose fatty acid esters—hardly a teaching away—and further, the ultimate emulsifier—sucrose acetate butyrate—is taken not from Yamada but from Takahashi. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See MPEP 2145 IV, *In re Keller*, 642 F2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F2d 1091, 231 USPQ 375 (Fed Cir 1986).

Appellant further argues that Takahashi merely lists many different types of emulsifiers useful as alternatives or in combination in the Takahashi technology but teaches nothing about equivalence of the emulsifiers in the appellant's technology; however, Takahashi teaches a finite number—16—of potential emulsifiers, and clearly

teaches, as applicant admits in their argument, that the sucrose acetate butyrate is an alternative to the sucrose esters of Sakurada and Yamada. In response to applicant's argument that Takahashi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In this case, Takahashi is both in the field of applicant's endeavor—that is within the technology of food processing—and reasonably pertinent to the particular problem with which the applicant was concerned—that is the emulsification of foodstuffs. See MPEP 2141.01(a) and *In re Oetiker*, 977 F2d 1443, 24 USPQ2d 1443 (Fed Cir 1992).

Regarding appellant's argument that Takahashi fails to suggest the emulsification and stabilization of polyunsaturated fatty acids and that neither of Sakurada nor Yamada teaches sucrose acetate butyrate as an emulsifier, it is again noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See MPEP 2145 IV, *In re Keller*, 642 F2d 413, 208 USPQ 871 (CCPA 1981) and *In re Merck & Co.*, 800 F2d 1091, 231 USPQ 375 (Fed Cir 1986).

Appellant further argues that the examples of Takahashi require plural emulsifiers; however, first, the teachings of Takahashi are not limited to the examples and Takahashi clearly teaches the emulsifiers used "individually or as a combination of two or more thereof" (0029), which meets the claims; and second, were Takahashi limited to the teachings of the examples, plural emulsifiers would still meet the claims

since appellant uses the transitional term ‘comprising’ which is inclusive or open-ended and does not exclude additional, unrecited elements such as additional emulsifiers.

See MPEP 2111.03 and *Mars Inc v H J Heinz Co*, 377 F3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed Cir 2004)

Regarding the declaration of Makoto Ishikawa, filed 31 January 2008 under 37 CFR 1.132 (Ishikawa hereinafter):

Ishikawa purports to show unexpected results over Sakurada in that the odor of fish oil was unexpectedly better suppressed in samples containing the claimed sucrose acetate butyrate than in those samples containing sucrose fatty acid esters as taught by Sakurada.

Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the “objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support.” In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. See MPEP 716.02(d) and *In re Clemens*, 622 F2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). In this case, the experimental samples tested are not commensurate in scope with the instant claims in that the entire range of polyvalent unsaturated fatty acid component is not shown and the instant claims do not require fish oil, are not limited to the vegetable oil of Ishikawa; do not require the glycerol components of Ishikawa.

Further, it is the position of the examiner that the data presented is insufficient to show unexpected results in that only a small sample of people, of unknown qualification, was used and that the raw results of the tests were not reported but rather were rolled-up into broader categories (0-2 vs 3-5 vs 6-10).

Finally regarding Ishikawa it is noted that the qualifications of the testers employed, the explanation of the presence of glycerol and the raw data table were not presented in Ishikawa, but are rather arguments of counsel. A showing of unexpected results must be based on evidence, not argument or speculation. See MPEP 2145 and *In re Mayne*, 104 F3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed Cir 1997)

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Timothy J. Kugel/  
Primary Examiner, Art Unit 1796

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